

infringed the original patent claims since the invention of the original patent claims has a circular contour portion. The statement of the rejection concluded with the recitations that a claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent, and that a claim is broadened if it is broader in any one respect even though it may be narrower in other respects. Applicant respectfully submits that this reasoning and the conclusion drawn therefrom are in error such that the rejection is improper and should be withdrawn.

The conclusion in the Office Action rejection that the described hypothetical process, namely including the additional step of further turning the circular contour portion into a square contour portion resulting in an invention that has a square contour portion, if practiced, would not have infringed the original patent claims of the original patent, is not a correct statement under the U.S. patent law. The statute, 35 U.S.C. §271(a), expressly provides that “whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.”

Chisum on Patents states that in listing “making” as one of the patentee’s basic rights, Section 271(a) uses the disjunctive “or”. This codifies the long-standing rule that making a patented product without use or sale will constitute infringement, E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co., 2 USPQ 2d 1545, 1574 (D. Del. 1987), *affd. in part, rev’d in part, vacated in part & remanded* 849 F.2d 1430, 7 USPQ 2d 1129 (Fed. Cir. 1988) (“if the

melt index of a Phillips copolymer product as fluff, is within the melt index range of an inserted claim, then that Phillips product infringes that claim on the basis of melt index, even though the melt index of the extruded, pelletized product as sold is outside of the melt index range of the asserted claim"). That is, one making the product using the method of claims 45-53 would infringe the original patent, for example claim 1 of U.S. Patent No. 5,230,747, even though the product as sold was subsequently modified by providing the square contour portion as proposed in the hypothetical set forth in the rejection of claims 45-53 under 35 U.S.C. §251. Thus, it is respectfully submitted that application claims 45-53 are not broadened under 35 U.S.C. §251 for the reasons alleged in the Office Action rejection of the claims.

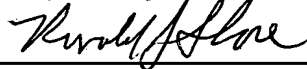
As stated in the remarks in Applicant's Amendment filed March 7, 2005, claims 45-53 in the present application for reissue are each directed to a process for producing a semiconductor device which includes providing a wafer which includes each of the limitations of claim 1 of U.S. Patent No. 5,230,747. Thus, claims 45-53 are not broader than claim 1 of U.S. Patent No. 5,230,747. The product made by a process which infringes any of claims 45-53 would also infringe claim 1 of the original patent because under 35 U.S.C. §271(a), it is an infringement to make a patented product without authority.

In view of the above remarks, it is respectfully submitted that claims 45-53 are now in condition for allowance. Accordingly, reconsideration and allowance of these claims is respectfully requested.

A Petition for Extension of Time to permit the timely filing of this Request for Reconsideration within the third month extension of time for responding to the Office Action of July 14, 2005 is filed herewith.

Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (Case No. 1374.20289RC6) and please credit any excess fees to such deposit account.

Respectfully submitted,



---

Ronald J. Shore

Registration No. 28,577

ANTONELLI, TERRY, STOUT & KRAUS, LLP

RJS/kmh

Attachments